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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,722	05/23/2001	John R. Martin	10527US16	2165

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 01/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,722

**Applicant(s)**

MARTIN ET AL.

**Examiner**

Thomas A. Dixon

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 16-17, 20-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22-27 is/are allowed.
- 6) ☒ Claim(s) 16, 17, 20, 21 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The request filed on 2/14/05 for Continued Examination (RCE) based on parent Application No. 09/863,722 is acceptable and an RCE has been established. An action on the RCE follows.

2. The Terminal Disclaimer filed on 2/25/03 is acceptable

### ***Priority***

3. This application's claim for continuity data is inconsistent with PTO records according to the Bib Data Sheet.

Appropriate correction is required.

### ***Response to Amendment***

4. Applicant's amendment to the claims remarks that applicant's new claims 29-30 are applicable to a computer jukebox in any suitable environment including private residence, however, in arguments regarding the applicability of Castille, page 9, states that jukeboxes are commonly found in establishments such as restaurants and bars but not in homes. Applicant also argued that the 1) storing digitally compressed song related pictorial graphics, 2) money intake device and 3) user attract mode distinguished the invention.

Money intake devices and a user attract mode are both well known in the entertainment machine arts and would therefore not be seen as a reason for allowance in the art.

A review of the claims finds the compressed pictorial graphics of claim 16 are never decompressed, a 112 rejection is below.

A review of the claims finds that independent claims 22 and 27 do not contain compressed song related pictorial graphics.

5. No reasons for allowance were given for claim 28, applicant's statements regarding them are unfounded.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 28 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The received "pictorial graphics" are not enabled by the specification. These pictorial graphics are compressed digital images according to the specification and their decompression before display critical or essential to the practice of the invention, but is not included in the claim(s).

7. Claim 29 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The "digitally stored song associated graphics" are not enabled by the specification. These pictorial graphics are compressed digital images according to the specification and their decompression before display critical or essential to the practice of the invention, but is not included in the claim(s).

Further the compressed digital song data and digital graphics are never stored.

8. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The "digitally stored song associated graphics" are not enabled by the specification. These pictorial graphics are compressed digital images

according to the specification and their decompression before display critical or essential to the practice of the invention, but is not included in the claim(s).

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "graphic images" in line 25. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01.

The omitted elements are: decompression of the compressed pictorial graphics, which would be essential to the display of the graphics.

10. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites the limitation "digitally stored song associated pictorial graphics" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 29-30 is rejected under 35 U.S.C. 102(e) as being anticipated by Stern et al (5,084,768).

As per Claim 29.

Stern et al (5,084,761) discloses:

a processor and a memory, see figure 8 (14) and a display (34) and generating a user attract mode in which song associated graphics are shown on said display when no song is playing on the computer jukebox, see column 6, lines 35-58.

As per Claim 30.

Stern et al (5,084,761) discloses generating a user attract mode in which song associated graphics are shown on said display when no song is playing on the computer jukebox, see column 6, lines 35-58.

### ***Allowable Subject Matter***

12. Claims 22-27 are allowed.

13. The following is an examiner's statement of reasons for allowance:

As per Claim 22.

The prior art, specifically Castile ('502) in view of Cohen ('187) further in view of Verdun ('802) or Tashiro ('836) do not disclose or fairly teach:

a computer jukebox with a communication interface for receiving the compressed digital song data and the song identity data;

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox; and

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causing the management station processor to compress and transmit a subset of the digital song data and transmit corresponding song identity data to at least one selected computer jukebox to update the library of songs in the computer jukebox.

As per Claim 27.

The prior art, specifically Castile ('502) in view of Cohen ('187) further in view of Verdun ('802) or Tashiro ('836) do not disclose or fairly teach:

a computer jukebox with a communications interface for receiving compressed digital song data and the song identity data;

a data storage for storing the compressed digital song data and song identity data for each of the songs stored;

processor and a memory, the memory including a decompression algorithm for decompressing compressed digital song data, and instructions for:

causing the processor to respond to compressed digital song data and to song identity data, which may be received by the communication interface of the computer jukebox, to control the storage of the received compressed digital song data and the received song identity data in the data storage unit to create an updated library of songs stored in the computer jukebox.

The claims that depend from the above allowed claims are allowable for the same reasons.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Prior Art Made of Record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

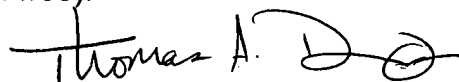
Arbiter et al (5,228,015) discloses running an attract mode until money is inserted, see column 5, lines 12-13, but does not disclose running compressed/decompressed digitally stored song associated graphics.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (571) 272-6803. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Thomas A. Dixon", with a stylized flourish at the end.

Thomas A. Dixon  
Primary Examiner  
Art Unit 3639

December 05